

**Remarks/Arguments**

Reconsideration of the above-identified application in view of the present amendment is respectfully requested. Claims 1-14 are pending in the present application. By the present amendment, claim 1 has been amended.

**Rejection of Claims 1-14 under 35 U.S.C. §103**

The Office Action of June 1, 2007 rejected claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,881,534 to Uhl et al. in view of U.S. Patent Application Publication No. 2003/0100905 to Mears. In response to this rejection, claim 1 in the application has been amended to more distinctly claim the invention and to more clearly define the invention over the cited references. It is respectfully submitted that the discussion below of the teachings of the cited reference, in conjunction with the amendment of claim 1, places all pending claims in condition for allowance.

As amended, claim 1 recites an apparatus for cutting bone. The apparatus comprises a shaft member having a central axis and extending between a proximal end portion and a distal end portion. The proximal end portion has a first surface adapted to receive repetitive impacts. The distal end portion includes a cutting blade that extends in a first plane between a shield section and a guide section. The shield section and the guide section are oppositely disposed about the central axis. The shield section and the guide section project axially beyond the cutting blade to recess the cutting blade in the distal end portion. The shield section includes an

inwardly facing shield surface which extends in a second plane that is transverse to the first plane of the cuffing blade.

It is respectfully submitted that the prior art references of record, whether taken alone or in combination, do not teach or disclose the features of claim 1 as amended. In particular, the prior art references of record do not teach an apparatus comprising a shield section and a guide section being oppositely disposed about a central axis.

The patent to Uhl et al. teaches an improved corticotomy osteotome intended for use in the Ilizarov techniques of limb lengthening and/or bone transport without bone grafting of the distraction gap. The patent to Uhl et al. does not teach an apparatus comprising a guide section as alleged in the Office Action. The alleged guide section is merely the bottom surface of the tool and is not capable of acting as a guide section since the bottom surface of the tool is never in contact with a solid surface that would guide the cutting blade of the apparatus. Furthermore, careful inspection of the patent to Uhl et al. reveals that the apparatus does not comprise any section that could serve to act as a guide section. Rather, to ensure that only cortical bone is being cut by the apparatus described in the patent to Uhl et al., the surgeon must select between an apparatus with appropriate dimensions so as to not accidentally cut surrounding soft tissue and non-cortical bone as set forth in column 5, lines 26-34. Therefore, it is respectfully submitted that no guide section exists in the patent to Uhl et al.

As noted by the Office Action, the patent to U et al. does not teach of an apparatus wherein the shield section and the guide section project axially beyond the

cutting blade to recess the cutting blade in the distal end portion, with the guide section comprising a blunt tooth. However, the patent application to Mears discloses the use of a cutter having a blade that is recessed within two guides with each guide including a bulbous tooth to prevent objects from contacting the blade. The patent application to Mears discloses a ligamentum teres femoris cutter configured for severing the ligamentum teres femoris prior to dislocating the femoral head from the acetabulum.

It is respectfully submitted that a combination of the teachings of the patent to Uhl et al. and the patent application to Mears does not result in the invention recited in amended claim 1, since such a proposed combination would fail to provide an apparatus comprising a shield section and a guide section being oppositely disposed about a central axis. Because the patent to Uhl et al. fails to teach of an apparatus comprising a guide section, the combination of the patent to Uhl et al. and the patent application to Mears would result in an apparatus comprising a blade recessed within two shield sections that would prevent objects from contacting the blade. Therefore, such a combination would not be obvious to one skilled in the art because it does not result in an apparatus comprising a shield section and a guide section being oppositely disposed about a central axis as recited in amended claim 1. Thus, it is respectfully requested that amended claim 1 defines over cited art and should be allowed.

Claims 2-7 in the application depend either directly or indirectly from claim 1 and are allowable for at least the reasons that claim 1 is allowable, and for the

specific limitations recited therein. Accordingly, it is respectfully requested that claims 2-7 be allowed.

Claim 8 recites an apparatus for cutting through the cortical bone of a vertebral body, the cortical bone having an outer peripheral surface and an inner surface surrounding cancellous bone. The apparatus comprises an elongate member having a shaft portion extending along a central axis between a proximal end portion and a distal end portion. The proximal end portion has a platform adapted to receive repetitive impacts to advance the elongate member along the vertebral body. The distal end portion of the elongate member includes an arcuate cutting blade extending in a first place between first and second tip portions. The cutting blade is adapted to cut through the cortical bone of the vertebral body as the elongate member is advanced. The first tip portion has a shield surface that extends in a second plane that is transverse to the first place of the cutting blade. The shield surface shields the cutting blade to prevent the undesired cutting of soft tissues present on the outer peripheral surface of the vertebral body. The second tip portion comprises a blunt tooth that extends generally parallel to the central axis and acts as a guide to ensure that the distal end portion of the elongate member follows the contours of the inner surface of the vertebral body as the elongate member is advanced.

It is respectfully submitted that the prior art references, whether taken alone or in combination, do not teach or disclose the features recited in claim 8. More specifically, none of the prior art references teach an apparatus comprising a distal end portion of an elongate member that includes an arcuate cutting blade extending

between first and second tip portions. As stated on page 4 of the present application, the arcuate cutting blade is adapted to cut through the cortical bone of a vertebral body as the elongate member is advanced.

In contrast, the patent to Uhl et al. and the patent application to Mears do not disclose an apparatus comprising an arcuate cutting blade. The patent to Uhl et al. comprises a distal end portion that includes a straight cutting blade as evidenced by Fig. 1 and Fig. 4. on page 1 of the drawing sheets. Likewise, the patent application to Mears comprises a straight blade recessed within two cuffing guides as evidenced by Fig. 2 on page 1 of the drawing sheets. Therefore, the patent to Uhl et al. and the patent application to Mears, whether taken alone or in combination, do not teach or disclose the features recited in claim 8 and therefore cannot be considered obvious to one skilled in the art. Thus, it is respectfully requested that claim 8 be allowed.

Claims 9-14 in the application depend either directly or indirectly from claim 8 and are allowable for at least the reasons that claim 8 is allowable, and for the specific limitations recited therein. Accordingly, it is respectfully requested that claims 9-14 be allowed.

It is respectfully submitted, that the discussion above of the teachings of the cited references, in conjunction with the amendment of the claim, places all pending claims in condition for allowance. Thus, allowance of the above-identified application is respectfully submitted.

In view of the foregoing, it is respectfully submitted that the above-identified application is in condition for allowance, and allowance of the above-identified application is respectfully requested.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,

/Richard S. Wesorick/

Richard S. Wesorick  
Reg. No. 40,871

TAROLLI, SUNDHEIM, COVELL,  
& TUMMINO L.L.P.  
1300 East Ninth Street, Suite 1700  
Cleveland, Ohio 44114  
Phone:(216) 621-2234  
Fax: (216) 621-4072  
Customer No.: 26,294